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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,336	04/01/2004	Andrew Greaves	05725.1348-00	5352

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EXAMINER	
ELHILO, EISA B	

ART UNIT	PAPER NUMBER
1751	

DATE MAILED: 11/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/814,336	GREAVES ET AL.	
	Examiner	Art Unit	
	Eisa B. Elhilo	1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *01 April 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-99* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *41-50 and 89-99* is/are allowed.

6)☒ Claim(s) *1-6 and 51-56* is/are rejected.

7)☒ Claim(s) *7-40 and 57-88* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *01 April 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *9/28/2004*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Claims 1-99 are pending in this application.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-6 and 51-56 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 16-18 and 46-48 of copending Application No. 10/814,300, over claims 6-8 and 36 of the copending Application No. 10/814,335, over claims 6-8 and 65 of the copending Application No. 10/814,428, over claims 5-7 of the copending Application No. 10/814337, over claims 32, 54 and 62 of the copending Application No. 10/814,585, over claim 6 of the copending Application No. 10/814,333, over claims 15-17 and 56 of the copending Application No. 10/814,236, over claims 24, 26-27 and 58-60 of the copending Application No. 10/814,338, over claims 5-7 and 46-48 of the copending Application No. 10/814,334, over claims 5-7 and 53-55 of the copending Application No.

10/814,430 and over claims 26-28 and 56-58 of the copending Application No. 10/814,305. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the copending Applications No. 10/814,300, 10/814,335, 10/814,428, 10/814,337, 10/814,585, 10/814,333, 10/814,236, 10/814,338, 10/814,334, 10/814,305 and 10/814,430, teach and disclose methods for dyeing keratin fibers and compositions comprising at least one fluorescent dye having formulae similar to the claimed formula as claimed in claims 1-6 and 51-57 (see claims 16-18 and 46-48 of the copending Application No. 10/814,300, claims 6-8 and 36 of the copending Application No. 10/814,335, claims 6-8 and 65 of the copending Application No. 10/814,428, claims 5-7 of the copending Application No. 10/814,337, claims 32, 54 and 62 of the copending Application No. 10/814,585, claim 6 of the copending Application No. 10/814,333, claims 15-17 and 56 of the copending Application No. 10/814,236, claims 24, 26-27 and 58-60 of the copending Application No. 10/814,338, claims 5-7 and 46-48 of the copending Application No. 10/814,334, claims 5-7 and 53-55 of the copending Application No. 10/814,430 and over claims 26-28 and 56-58 of the copending Application No. 10/814,305). Therefore, this is an obvious formulation.

Although, the claims of the copending Applications No. 10/814,300, 10/814,335, 10/814,428, 10/814,337, 10/814,585, 10/814,333, 10/814,236, 10/814,338, 10/814,334, 10/814,305 and 10/814,430, teach and disclose similar hair dyeing compositions, they are not identical to the instant claims because the claims of the copending Application No. 10/814,300 require at least one polyol component to be presented in the composition, the claims of the copending Application No. 10/814,335 require at least one cationic polymer to be presented in the composition, the claims of the copending Application No. 10/814,428, require at least one

aminosilicone component to be presented in the composition, the claims of the copending Application No. 10/814,337, require at least one conditioning agent to be presented in the composition, the claims copending Application No. 10/814,585, require at least one complexing agent to be presented in the composition, the claims of the copending Application No. 10/814,333, require at least one fluorescent dye to be presented in the composition, the claims of the copending Application No. 10/814,236, require at least one non associative thickening polymer to be presented in the composition, the claims of the copending Application No. 10/814,338, require at least one amphoteric surfactant to be presented in the composition, the claims the copending Application No. 10/814,334, require at least one conditioning polymer to be presented in the composition, the claims of the copending Application No. 10/814,430, require at least one acid functional group to be presented in the composition and the claims of the copending Application No. 10/814,305, require at least one associative polymer to be presented in the composition, while the current claims recite a hair dyeing formulation comprising the fluorescent compound only . Therefore, the conflicting claims are not identical.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to formulate such a composition for dyeing hair, because the copending Applications clearly teach and disclose compositions comprising the claimed formula of the fluorescent compound, and, thus, a person of the ordinary skill in the art would be motivated to formulate such a composition to arrive at the claimed invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 51-56 are rejected under 35 U.S.C. 102(b) as being anticipated by Degen et al. (US 4,256,458).

Degen et al. (US' 458) teaches a dyeing composition comprising a fluorescent compound having a formula (see cols.12 and 14, Example 6), which is identical to the claimed formula as claimed in claims 51-56, when in the claimed formula, R1-R2 are methyl radicals, R3-R6 are hydrogen atoms, a = 1 and X is an ethyl radical (-CH2-CH2-). Degen et al. (US' 458) teaches all the limitations of the instant claims. Hence, Degen et al. anticipates the claims.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Degen et al. (US 4,256,458).

Degen et al. (US' 458) teaches a dyeing composition comprising a fluorescent compound having a formula (see cols.12 and 14, Example 6), as claimed in claims 1-6, when in the claimed formula, R1-R2 are methyl radicals, R3-R6 are hydrogen atoms, a = 1 and X is an ethyl radical (-CH2-CH2-).

The instant claims differ from the reference by reciting a process for dyeing human keratin material.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to apply such a dyeing composition for dyeing hair with the reasonable expectation of success. Such a modification would be obvious because the reference teaches a dyeing composition comprising the same fluorescent dye compound and wherein the composition is suitable for dyeing fibers and, thus, a person of the ordinary skill in the art would have been motivated to apply such a composition for dyeing keratin material with the reasonable expectation of achieving excellent results and would expect that similar composition would have similar utilities, absent unexpected results. Further, the recitation of a new intended use for an old product does not make a claim to that old product patentable. (In re Schreiber, 44 USPQ2d 1429 (Fed. Cir. 1997).

Allowable Subject Matter

4. Claims 7-40 and 57-88 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art of record do not teach or disclose the limitations of these claims.

5. Claims 41-50 and 89-99 are allowed. The prior art of record do not teach or disclose the limitations of these claims.

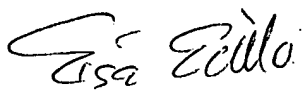
Conclusion

6 The remaining references listed on from 1449 have been reviewed by the examiner and are considered to be cumulative to or less material than the prior art references relied upon in the rejection above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eisa B. Elhilo whose telephone number is (571) 272-1315. The examiner can normally be reached on M - F (8:00 -5:30) with alternate Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on (571) 272-1316. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Eisa Elhilo
Primary Examiner
Art Unit 1751

November 14, 2005